

### **REMARKS**

Applicants have carefully reviewed the Application in light of the Office Action dated July 28, 2004. Claims 1-24 are pending and stand rejected. Applicants have amended Claims 5-7. Applicants respectfully submit that no new matter has been added by these amendments. For the reasons provided below, Applicants submit that the pending claims are patentably distinguishable over the cited reference. Therefore, Applicants respectfully request reconsideration and favorable action in this case.

#### **Section 112 Rejections**

The Examiner has rejected Claims 8-24 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim subject matter which applicant regards as the invention. In particular, the Examiner states that these "Claims include method steps while referring to a system." Applicants have amended Claims 5, the base claim for Claims 8-24, to include method limitations and have amended the preamble to recite "A method for dispensing fuel." Claims 6 and 7 have also been amended to include method limitations and to recite similar preambles. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of Claims 8-24 under 35 U.S.C. § 112.

In addition, the Examiner rejects Claims 8 and 11 under 35 U.S.C. 112, second paragraph. In particular, the Examiner states that the phrases "the identity of the user" and "the vehicle information" of Claims 8 and 11, respectively, lack antecedent bases. Applicants have amended Claim 8 to recite "an identity of the user" and Claim 11 to recite "vehicle information." Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of Claims 8-24 under 35 U.S.C. § 112.

#### **Section 102 Rejections**

The Examiner has rejected Claims 1-24 under 102(e) as being anticipated by U.S. Patent Publication 2003/0075600 to Struthers et al ("*Struthers*"). Applicants respectfully traverse these rejections for the following reasons.

As an initial matter, Applicants note that *Struthers* has an actual filing date (Sept. 30, 2002) that is after the filing date of the present application (January 9, 2002) and therefore cannot be used to reject the claims under 102(e) or 102(e)/103 unless there is "proper support for the subject matter as required by 35 U.S.C. 119(e) or 120," in a priority document with a filing date earlier than the present application (and subject to any possible swear behind). M.P.E.P. § 706.02(f)(1), Example 2. In the present case, the provisional application relied upon for priority (Provisional Application No. 60/325,518 filed on Sept. 28, 2001) was not included in the Office Action, nor was any indication given in the Office Action of what elements in the provisional application were intended to provide "proper support for the subject matter" in *Struthers* used in rejecting the claims. Accordingly, Applicants respectfully request that the Examiner identify the proper support for the subject matter relied upon. If there is no such support in the provisional application dated Sept. 28, 2001, the Office Action rejects the claims based solely on material filed in the PTO after the filing date of Applicant's application.

Even if the provisional application does provide support for the portions of *Struthers* used in the rejections, the rejections would nevertheless be improper because that publication does not teach each and every limitation of the claims. For example, Claim 1 recites that information unrelated to the manner in which a user will pay to dispense fuel is displayed "as a function of the manner in which the user will pay to dispense fuel." For the teaching of this limitation, the Examiner offers several passages that merely teach displaying retail information to a customer. *Struthers*, Page 3, Paragraph [0045]. But Applicants submit that the Office Action fails to consider each and every word of Claim 1. "All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). In judging the patentability of Claim 1, the Office Action fails to consider at least the phrase "display information on the display as a function of the manner in which the user will pay to dispense fuel." More particularly, the Office Action fails to consider at least the phrase "as a function of the manner in which the user will pay to dispense fuel."

*Struthers*, in contrast, merely teaches displaying retail information in response to a customer's selection, allowing a customer to purchase items in an associated convenience store. *Struthers*, Summary of the Invention. In particular, *Struthers* teaches a display of a fuel dispenser presenting retail button objects to a customer such that retail information is displayed in response to a customer selecting one of these buttons. Page 5, [0073]-[0076]. For example, the display of the fuel dispenser may present the customer with button objects such as Deli button object, Car Wash button object, and Game button object. *Struthers*, Page 5, [0073]. If a customer selects the Deli button object, for example, the fuel dispenser will present food choices to the customer. *Struthers*, Page 5, [0074]. However, *Struthers* merely teaches displaying information not related to the manner in which the customer pays for the fuel in response to a selection by a customer, **not** "as a function of the manner in which the user will pay to dispense fuel."

Furthermore, there is no suggestion or motivation to modify *Struthers* to display the retail information "as a function of the manner in which the user will pay to dispense fuel" because this modification will change the principal of operation of *Struthers*. "If the proposed modification . . . of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." *In re Ratti*, 270 F.2d 810 (CCPA 1959). MPEP § 2143.01. The principal of operation of *Struthers* is to provide a customer transaction opportunities that are available at a convenience store based on menu-driven customer selections. *Struthers*, Page 2, [0044]. The design, construction, and use of a fuel dispenser as illustrated in *Struthers* that could display retail information "as a function of the manner in which the user will pay to dispense fuel" would require a substantial reconstruction and redesign of the elements of *Struthers*. Accordingly, Applicants respectfully request reconsideration and allowance of Claim 1 and its dependents.

Independent Claims 5 recites limitations that are similar, although not identical, to the limitation of Claim 1 discussed above. Therefore, this claim is allowable for reasons analogous to those discussed above in connection with Claim 1. Claims 6-24 each depend from independent Claim 5 and are thus also patentable over the cited art.

Applicant : Jacobs et al.  
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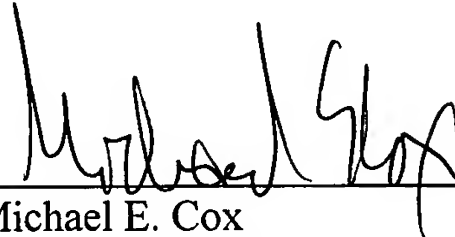
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It is believed no fees are due at this time. However, please apply any other charges or credits to deposit account 06-1050.

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Respectfully submitted,



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